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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/360,521	07/23/1999	SERGE RESTLE	05725.0446-0	4299

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EXAMINER
WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/360,521	RESTLE ET AL.	
	Examiner	Art Unit	
	Lauren Q Wells	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 February 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims 1-46 are pending.

Request for Continued Examination

The request filed on February 4, 2002 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/360521 is acceptable and an RCE has been established. An action on the RCE follows.

Double Patenting

Claims 1-46 directed to an invention not patentably distinct from the claim of commonly assigned Patent Numbers 6,028,041; 6,159,914; 6,162,424; 6,290,944. Specifically, all claims are directed toward analogous hair compositions comprising aminated silicones, amphoteric surfactants and anionic surfactants.

Commonly assigned 6,028,041; 6,159,914; 6,162,424; 6,290,944 discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-46 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,028,041; 6,159,914; 6,162,424; and 6,290,944. Although the conflicting claims are not identical, they are not patentably distinct from each other because all sets of claims are drawn towards analogous hair compositions comprising aminated silicones, anionic surfactants, and amphoteric surfactants.

Claims 1-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-66 of copending Application No. 09/759,165. Although the conflicting claims are not identical, they are not patentably distinct from each other because all sets of claims are drawn towards analogous hair compositions comprising aminated silicones, anionic surfactants, and amphoteric surfactants..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The phrase "quaternary derivatives of cellulose ether" in claim 34 (line 2) is vague and indefinite, as the metes and bounds of the phrase are not ascertainable. It is not known what compounds are encompassed by this phrase. The specification does not define this phrase and one of ordinary skill in the art would not be apprised of it.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-32 and 34-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Decoster et al. (6,028,041).

Decoster et al. teach a detergent and conditioning hair-car composition comprising, in a cosmetically acceptable medium a washing base and a conditioning system comprising at least one cationic polymer, at least one animated silicone and at least one insoluble silicone. The washing base is disclosed as comprising one or more surfactants selected from anionic, amphoteric, nonionic, cationic and mixtures thereof, wherein a mixture of anionic and amphoteric surfactants is preferred. Aminated silicones of formula (I) and (IV) of the instant invention are disclosed. Specifically disclosed is a composition comprising 14 g sodium lauryl ether sulfate (anionic surfactant), 4.6 g MIRANOL C2M (amphoteric surfactant), 0.1 g cationic polymer, and 1.05 g aminated silicone. See Col. 2, line 30-Col. 20, line 10.

Claims 1-32 and 34-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Decoster et al. (6,159,914).

DeCoster et al. teach a detergent composition comprising in a cosmetically acceptable medium, a washing medium comprising 1-50% of at least one ether sulfate anionic surfactant and 1-50% of at least one surfactant of alkylbetaine type (amphoteric surfactant) and a conditioning system comprising at least one cationic polymer, and 0.05-10% of at least one aminosilicone. Aminosilicones of formula (I) and formula (IV) of the instant invention are disclosed. Water, ethanol, isopropanol, butanol and mixtures of water and propylene glycol or glycol ethers are disclosed as cosmetically acceptable mediums. The compositions is disclosed for hair care as a shampoo and conditioning composition. Specifically disclosed is a composition comprising 15.5 g sodium lauyrl ether sulfate (anionic surfactant), 3.2 g cocobetaine

containing A.M. (amphoteric surfactant), 0.6 g cationic polymer, and 2.45 g aminosilicone. See Col. 3, line 1-Col. 16, end.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sebag et al. (WO 96/03155) in view of Hughes (5,567,428) in further view of Naito (5,476,64).

Sebag et al. teach washing and conditioning compositions containing silicone and dialkyl ether. Disclosed are compositions comprising at least one silicone, at least one surfactant, and at least one dialkylether in a cosmetically acceptable aqueous medium. Polyorganosiloxanes containing substituted or unsubstituted amine groups are disclosed. A mixture of anionic surfactant with amphoteric surfactant is disclosed as a being added to the composition. The surfactants are disclosed as comprising 5-50% of the composition. Ethanol, isopropanol, butanol, propylene glycol and glycol ethers are disclosed as solvents in the aqueous medium. Synthetic oils and cationic polymers of formula (a) of the instant invention are disclosed as additives. Example 1 teaches a shampoo comprising imidazoline-based amphoteric surfactant and sodium lauryl ether sulphate (anionic surfactant) in a ratio of 2/7. The reference fails to teach preferred aminated silicones and 18-methyl-eicosanoic acid. U.S. 6,162,432 is relied upon as a translation for WO 96/03155. See Col. 2, line 26-Col. 24, line 10.

Hughes teaches topical personal care compositions containing polysiloxane-grafted adhesive polymers. Disclosed is a hair styling/conditioning rise composition comprising trimethylsilylamodimethicone, ditallow dimethyl ammonium chloride (cationic polymer), tallow trimethyl ammonium chloride (cationic polymer), and amodimethicone, which meets claims 13-21, 26-31. Cationic polymers disclosed include diallyldimethylammonium salt homopolymers, copolymers of diallyldimethylammonium salt and acrylamide, cationic polysaccharides, and copolymers of vinylpyrrolidone and methylvinylimidazolium salt, which meets claims 34, 36-38. Carriers disclosed include C1-C12 alcohols, such as ethanol, which meets claims 40 and 42. Disclosed as polymer plasticizing agents are glycerin (glycerol) and propylene glycol comprising 0.01-10% of the composition, which meets claims 40-43. See Col. 2, lines 42-Col. 3, line 55; Col. 11, line 15-Col. 36, line 12; Col. 37, line 61-Col. 40, line 11.

Naito et al. teach hair cosmetic compositions comprising branched fatty acids. 18-methyleicosanoic acid is disclosed as the preferred branched fatty acid. See Col. 1, line 53-Col. 5, line 58; Col. 8, line 34-Col. 26, line 33.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the alkylamino substituted silicones of Hughes for the aminated silicones of Sebag et al. because a) both references teach cosmetic compositions for use on hair; b) both references teach aminated silicones as active agents; c) Hughes teaches his aminated silicones as increasing style hold strength of hair and as decreasing drying time; hence, the replacement of one for the other for cosmetic purposes would be within the skill of one in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the 18-methyl-eicosanoic acid of Naito et al. to the composition of the

combined references because a) the combined references and Naito et al. both teach hair cosmetic compositions; b) Sebag et al. teach synthetic oils as additives and 18-methyl-eicosanoic acid is a synthetic oil; c) Naito et al. teach 18-methyl-eicosanoic acid as giving hairs excellent moist, soft, smooth and glossy conditioning effects which continue to persist after repeated shampooings; hence, the addition of 18-methyl-eicosanoic acid to the compositions of the combined references for the cosmetic treatment of hair would be within the skill of one in the art.

Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decoster et al. (6,162,424) in view of Hughes in further view of Naito et al.

Decoster et al. teach cosmetic compositions comprising, in a cosmetically acceptable medium, at least one silicone and at least one polymer containing units of the diallydimethylammonium type. Amodimethicone and trimethylsilyamodimethicone are disclosed as silicones. Surfactants are disclosed as part of the composition, wherein a mixture of at least one anionic surfactant and at least one amphoteric surfactant is preferred. Surfactants can comprise 0.1-60% of the composition. Synthetic oils are disclosed as additives. Example 1 teaches a composition comprising sodium lauryl ether sulphate (anionic surfactant), aminosilicone, and diallyldimethylammonium chloride homopolymer (amphoteric surfactant). The reference fails to teach preferred aminated silicones, 18-methyl-eicosanoic acid, and preferred solvents. See Col. 1, line 30-Col. 16, end.

Hughes is disclosed as discussed above.

Naito et al. is disclosed as discussed above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the alkylamino substituted silicones of Hughes for the aminated silicones of Decoster et al. because a) both references teach cosmetic compositions for use on hair; b) both references teach aminated silicones as active agents; c) Hughes teaches his aminated silicones as increasing style hold strength of hair and as decreasing drying time; hence, the replacement of one for the other for cosmetic purposes would be within the skill of one in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the 18-methyl-eicosanoic acid of Naito et al. to the composition of the combined references because a) the combined references and Naito et al. both teach hair cosmetic compositions; b) Decoster et al. teach synthetic oils as additives and 18-methyl-eicosanoic acid is a synthetic oil; c) Naito et al. teach 18-methyl-eicosanoic acid as giving hairs excellent moist, soft, smooth and glossy conditioning effects which continue to persist after repeated shampooings; hence, the addition of 18-methyl-eicosanoic acid to the compositions of the combined references for the cosmetic treatment of hair would be within the skill of one in the art.

Claims 1 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decoster et al. (6,159,914) in view of Naito et al.

Decoster et al. is disclosed as discussed above. The reference fails to teach 18-methyl-eicosanoic acid.

Naito et al. is disclosed as discussed above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the 18-methyl-eicosanoic acid of Naito et al. to the composition of the

combined references because a) the combined references and Naito et al. both teach hair cosmetic compositions; b) Decoster et al. teach synthetic oils as additives and 18-methyl-eicosanoic acid is a synthetic oil; c) Naito et al. teach 18-methyl-eicosanoic acid as giving hairs excellent moist, soft, smooth and glossy conditioning effects which continue to persist after repeated shampooings; hence, the addition of 18-methyl-eicosanoic acid to the compositions of the combined references for the cosmetic treatment of hair would be within the skill of one in the art.

Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morlino (4,185,087) in view of Sebag et al. in further view of Naito et al.

Morlino teaches hair conditioning compositions containing dialkylamino hydroxy organosilicon compounds and their derivatives. Disclosed is a method of condition hair which comprising applying to the hair an effective amount of a composition containing 0.1-10%of formula (IV) of the instant invention, 75-99.9% water, 0-30% of one or more amphoteric, cationic, anionic, non-ionic, polar non-ionic or zwitterionic surfactants, which meets claims 1-5, 22-25, 32, 39, 43-46. The anionic surfactant is disclosed as comprising up to 8% of the composition, while the amphoteric surfactant is disclosed as comprising 9-30% of the composition, see Col. 3, lines 45-54 and Col. 6, lines 41-50, which meets claims 6-12. See Col. 1, line 6-Col. 9, line 16; Col. 11, line 48-Col. 14, line 15. The reference fails to teach aminated silicone polymers, 18-methyl-eicosanoic acid, cationic polymers, and cosmetically acceptable solvents.

Sebag et al. is disclosed as discussed above.

Naito et al. is disclosed as discussed above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the cationic polymers of Sebag et al. to the composition of Morlino because a) both references teach hair conditioning compositions comprising aminated silicones, anionic surfactant, and amphoteric surfactant; b) Morlino teach that ingredients well known to be capable of use in hair care formulations can be added to his composition and he also teaches that other conditioning agents known to those of skill in the art can be added to the composition; c) Sebag et al. teach cationic polymers as well known conditioning agents in hair care compositions; hence, adding cationic polymers to the composition for hair conditioning purposes would be within the skill of one in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the 18-methyl-eicosanoic acid of Naito et al. to the composition of Morlino because a) Morlino and Naito et al. both teach hair conditioning compositions; b) Naito et al. teach 18-methyl-eicosanoic acid as giving hairs excellent moist, soft, smooth and glossy conditioning effects which continue to persist after repeated shampooings, and; c) Morlino teach that ingredients well known to be capable of use in hair care formulations can be added to his composition and he also teaches that other conditioning agents known to those of skill in the art can be added to the composition; hence, the addition of 18-methyl-eicosanoic acid to the compositions of the combined references for the cosmetic treatment of hair would be within the skill of one in the art.

The claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references. Therefore, the claims are properly rejected under 35 U.S.C. § 103.

Unexpected Results

It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

In the instant case, the data on pages 20-23 of the specification have been considered but not found persuasive because the data merely demonstrate the effectiveness of a composition comprising an amphoteric surfactant:anionic surfactant ratio of 1:3, whereas the claims are directed to a much broader amphoteric surfactant:anionic surfactant ratio. Hence, the unexpected results are not commensurate in scope with the claimed invention. Furthermore, such results would be expected from the prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on T-F (6-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
February 27, 2002

MINNA MOEZIE, J.D.
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